

REMARKS

In regard to section 2 of the office action, claim 8 has been amended above to overcome the examiner's rejection. The scope of the claim has not been narrowed or limited by this amendment.

Claims 3, 5, 6, 24 and 25 have been converted from dependent form into independent form. In view of section 10 in the office action, these claims should now be in condition for allowance.

Claims 1 and 12-14 were rejected under 35 U.S.C. §102(b) as being anticipated by Sato (US 3557780). Claims 1 and 14-16 were rejected under 35 U.S.C. §102(e) as being anticipated by Ouchi (US 6547723). Claims 8-11 and 17-21 were rejected under 35 U.S.C. §103(a) as being unpatentable over Sato (US 3557780). Claims 8-11 and 17-21 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ouchi (US 6547723). Claims 1, 2, 12 and 13 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kato (JP 9-24019) in view of Sato (US 3557780). The examiner is requested to reconsider these rejections.

Claim 1 has been amended above to clarify applicants' claimed invention. In particular, claim 1 claims that the ureteropyeloscope is sized and shaped to be placed in a calyx of a lower pole of a kidney without passively deflecting the front end of the shaft against tissue of the kidney of a patient to reach the calyx of the lower pole. This is not merely an intended use of the ureteropyeloscope. This is a structural and functional limitation regarding the claimed

ureteropyeloscope. The examiner is directed to MPEP §2173.05(g). A function limitation is an attempt to define something by what it does, rather than by what it is. There is nothing inherently wrong with defining some part of an invention in functional terms. A functional limitation **must be evaluated and considered**, just like any other limitation of the claim. Nowhere in the cited are these claimed features disclosed or suggested. Nowhere in Sato or Ouchi is there a disclosure or suggestion of a ureteropyeloscope which is sized and shaped to be placed in a calyx of a lower pole of a kidney without passively deflecting the front end of the shaft against tissue of the kidney of a patient to reach the calyx of the lower pole. Furthermore, Ouchi has a U.S. filing date of June 6, 2000, whereas the present application claims priority back to October 26, 1999 as a continuation-in-part of U.S. 09/427,164. The features of claim 1 are not disclosed or suggested in the cited art. Therefore, claim 1 is patentable and should be allowed.

Though dependent claims 2 and 8-16 contain their own allowable subject matter, these claims should at least be allowable due to their dependence from allowable claim 1. However, to expedite prosecution at this time, no further comment will be made.

Claim 17 has not been amended. Claim 17 claims a shaft comprising a front end with two superelastic tube frame pieces connected in series, wherein a first one of the frame pieces forms a first active deflection section adapted to deflect in a first direction about 155°-190° with a radius of curvature of about 9-12 mm, and wherein a second one of the frame pieces

forms a second active deflection section adapted to deflect in a direction substantially the same as the first direction about 125° - 165° with a radius of curvature of about 9.5-13 mm. Nowhere in the cited art is there a disclosure or suggestion of applicants' claims angles and radii. The angles and radii are not merely "design choice" as stated by the examiner. The angles and radii are so very small that it requires a special structure to accomplish these angles and radii. The cited art does not disclose or suggest structure which is capable of achieving the claimed angles and radii and still function in their intended uses (i.e., with the control and image transmission members passing through the shafts). Applicants, on the other hand, have discovered a structure which is capable of obtaining the claimed angles and radii. Thus, a distal end of a ureteropyeloscope can be formed with the claimed invention which can be inserted into a calyx of a lower pole of a kidney without passively deflecting the front end of the shaft against tissue of the kidney of a patient to reach the calyx of the lower pole. The claimed angles and radii allow this to be done.

In one type of embodiment the structure comprises two superelastic tube frame pieces to accomplish the claimed angles and radii. Applicants have found that this structure allows the claimed angles and radii to be provided and still allow the shaft to function in its intended purpose. In alternate embodiments, at least one superelastic tube frame piece could be replaced by an equivalent structure, but on if the equivalent structure is shown to accomplish the same claimed angles and radii. The cited art does not disclose or

suggest structures which can accomplish the claimed angles and radii because of the very small nature of the claimed radii and relatively large angles. There is no disclosure or suggestion in the cited art of a structure which can accomplish the claimed angles and radii. Therefore, claim 17 is patentable and should be allowed.

Though dependent claims 18-23 contain their own allowable subject matter, these claims should at least be allowable due to their dependence from allowable claim 17. However, to expedite prosecution at this time, no further comment will be made.

Claims 30 and 31 have been added above to further claim the broadened features recited therein.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issue remain, the examiner is invited to call applicants' attorney at the telephone number indicated below.



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1/6/04
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